



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,158	03/19/2001	Robert L. Battey	10961158-2	2950

7590 03/18/2004
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

NGHIEM, MICHAEL P

ART UNIT	PAPER NUMBER
----------	--------------

2863

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,158

Applicant(s)

BATTEY ET AL.

Examiner

Michael P Nghiem

Art Unit

2863

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-20 and 22-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 and 22-30 is/are allowed.
- 6) ☒ Claim(s) 16 and 17 is/are rejected.
- 7) ☒ Claim(s) 18 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Communication filed on March 1, 2004 has been acknowledged.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Cowger et al. (US 5,788,388).

Cowger et al. discloses all the claimed features of the invention including:

Regarding claim 16, a replaceable ink container (12) for use in an off axis printing system (Fig. 1), the printing system being responsive to electrical signals produced by the replaceable ink container for controlling printing system parameters (Fig. 2), the replaceable ink container having a leading edge (bottom edge of 12) defined as that

edge of the replaceable ink container first received by the printing system (Fig. 3), the replaceable ink container comprising:

- a plurality of electrical contacts (contacts of 72) on a first half of the leading edge at a first side of the leading edge (Fig. 3), the plurality of electrical contacts configured for engaging a plurality of corresponding electrical printer contacts (56's) of the printing system (Fig. 3);
- a fluid outlet (66) on a second half of the leading edge at a second side of the leading edge that is directly opposite to the first side (Fig. 3) such that the fluid outlet is separated from the plurality of electrical contacts (Fig. 3), the fluid outlet being in fluid communication with the replaceable ink container (Fig. 3) and configured for engaging a fluid inlet (52) of the printing system;
- an information storage device (20) electrically connected to the plurality of electrical contacts (Fig. 3).

Regarding claim 17, the leading edge defines a longitudinal axis with the first side and the second side being disposed on the longitudinal axis (lateral axis of bottom edge).

Allowable Subject Matter

2. Claims 18 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

3. Claims 20 and 22-30 are allowed.

Reasons For Allowance

4. The combination as claimed wherein a replaceable ink container comprising the latch feature is in engagement with corresponding engagement features of the printing system (claim 18) or the electrical interface portion including an engagement portion separated from and positioned opposite to the plurality of electrical contacts (claim 20) or the electrical interface portion is a cavity within the leading edge of the replaceable ink container, the cavity being bisected by the longitudinal axis and having an inner surface with the plurality of electrical contacts thereon (claim 26) is not disclosed, suggested, or made obvious by the prior art of record.

Response to Arguments

5. Applicant's arguments filed on March 1, 2004 have been considered but they are not persuasive.

With respect to the 35 USC 102 rejections of claims 16 and 17, Applicants argue that Cowger does not qualify as a reference under 35 USC 102(e). The subject matter of claims 16 and 17 are disclosed at least as early as the January 8, 1996 filing date of US Patent 5,699,091 ('091).

Examiner's position is that US Patent ('091) does not disclose "a plurality of electrical contacts **on a first half of the leading edge at a first side of the leading edge**" as

recited in claim 16. It is clear from Figs. 4 and 5 of Patent ('091) that the plurality of electrical contacts (72) are not located on the leading edge of ink cartridge (60). Rather, they are located on a front surface of (60) and are spaced apart from the leading edge (see Fig. 5). Furthermore, the fluid outlet (64) is located on a second half of the leading edge at a second side of the leading edge (Figs. 4, 5) but is not directly opposite to the side where the electrical contacts (72) are located (Fig. 5). Thus, claims 16 and 17 cannot benefit from the filing date of US Patent ('091); hence, Cowger qualifies as a reference under 35 USC 102(e).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Contact Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Nghiem whose telephone number is (571) 272-2272. The examiner can normally be reached on M-H from 6:30AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached at (571) 272-2269. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



MICHAEL NGHIEM
PRIMARY EXAMINER
Michael Nghiem

March 15, 2004